

BEST AVAILABLE COPYAttorney's Docket: 2000DE135
Serial No.: 10/004,601
Art Unit: 1756REMARKS

The Office Action mailed February 11, 2005, has been carefully considered. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been introduced. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

Claim Status

Claims 1, 2, 4-16, 18-20, 22 and 23 are pending in this Application. By this Amendment, Applicants have amended claims 12 and 13. Claims 1, 2, 4-16, 18-20 and 22 stand rejected while 23 is objected to.

Claim Objections

Claim 12 stand objected to under 37 CFR § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 12 has been amended deleting the phrase "and powder toners".

Claim Rejections Under 35 USC § 112, First Paragraph

Claims 1, 2, 4-16, 18-20 and 22 stand rejected under 35 USC § 112, first paragraph as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Office is of the position that the "specification as filed does not disclose the claimed process steps (e.g. homogeneously incorporating, grinding, and classifying as specified) for the production of a liquid toner." Applicants courteously can not agree.

The step of "homogeneously incorporating" is recited on page 23, paragraph 0079, and refers explicitly to liquid and dry toners on the fourth line of paragraph 0079.

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With regarding the steps of "grinding and classifying" both are disclosed in Example 4. The steps recited in Example 4, however, are not limited to a dry binders. Depending upon the physical state of the toner binder (dry resin as exemplified in Example 4 as Bisphenol A, a high-boiling inert solvent, such as hydrocarbons (page 23, paragraph 0076) or an aqueous basis (page 23, paragraph 0077)), the resulting electrophotographic toner will be either a dry powder or a liquid.

An examination of Example 4 indicates that the written description requirement mandated by § 112, first paragraph has been met by the specification. The term used in Example 4 is that of a "toner binder" rather than a "binder resin." The particular toner binder used in Example 4 was a polyester resin based on Bisphenol A, identified in the example by parenthesis. A toner binder, as is known to one of ordinary skill in the art, encompasses all kinds of toner binders, such as solids, e.g., polyester resins, liquid hydrocarbons and liquid aqueous systems. In view of this, it is respectfully contended that one with ordinary skill in the art would readily understand that the mixture (dry or liquid so formed) is ground and classified. In consequence, it is respectfully contended that the written description requirement of 35 USC § 112, first paragraph has been sufficed. Applicants, therefore courteously request reconsideration and withdrawal of the rejection.

As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

In view of the forgoing amendments and remarks, the present Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,


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